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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,471	07/24/2001	Theodore M. Wong	SP-1093.3	6281

7590

01/28/2004

Richard B. Taylor  
P. O. Box 88940  
St. Louis, MO 63188

EXAMINER
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WARE, DEBORAH K

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/912,471

### Applicant(s)

WONG ET AL.

### Examiner

Deborah K. Ware

### Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 81-132 is/are pending in the application.
- 4a) Of the above claim(s) 126-132 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 81-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

New claims 81-132 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Papers filed***

The extension of time filed July 2, 2003 has been received. Further the amendments of July 2, 2003 and October 31, 2003 have been received and entered. Also the Terminal Disclaimer filed July 2, 2003 has been received and the miscellaneous letter filed October 31, 2003 has been received. Exhibits A and B filed concurrently with the amendment of July 2, 2003, have also been received. Exhibit A is a reference and Exhibit B is a declaration filed under 37 CFR 1.132.

#### ***Response to Amendment***

#### ***Election/Restrictions***

Newly submitted claims 81-132 are directed to inventions that are independent or distinct from the inventions originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 81-124, drawn to a method for washing soy protein to remove degraded RNA requiring as a first step forming an aqueous slurry and performing enzyme treatment classified in class 435, subclass 183.
- II. Claims 125-132, drawn to a method for producing a vegetable protein material, classified in class 424, subclass 725.

Art Unit: 1651

The inventions are distinct, each from the other because of the following reasons:

The invention of I and II are different and distinct from each other because each require different process steps wherein two additional steps are required of I and not II. Claims of II are independent and distinct from I in that claims of II are drawn to a vegetable protein and also II requires different process steps and none of the claims of I-II require any sequence of steps to be carried out and can be performed in any order per se. Further, a search which is required for one group is not required for another and a reference which reads on I may not read on II and I. In addition, different enzyme activities are required.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented inventions, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 125-132 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1651

***Double Patenting***

Claims 81-125 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 09/912,494. Although the conflicting claims are not identical, they are not patentably distinct from each other because of those reasons of record, note the office action of February 7, 2003, pages 3-4, paragraph 4, all lines.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants' Terminal Disclaimer filed July 2, 2003, is not proper in that it is terminally disclaiming the wrong provisional application, 09/912,424 and not 09/912,494. Therefore, the rejection is maintained.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 94-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 94-95 are rendered vague and indefinite for the recitation of "substantially all" wherein the phrase is not defined in the instant specification for its intended meaning in the claims. The metes and bounds of the claims can not be determined.

***Claim Rejections - 35 USC § 102/103***

Claims 81-125 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 380 343 cited of record and for those reasons of record, note office action of February 7, 2003, see pages 4-6, paragraph 7, all lines.

***Response to Arguments***

Applicant's arguments filed July 2, 2003 and October 31, 2003, have been fully considered but they are not persuasive. The argument that the reference does not disclose degrading RNA is noted. However, RNA is present in the soy protein which is disclosed by the cited reference. RNA contains phosphate groups and the acid phosphatase will cleave these phosphorous linkages in the RNA and thus, degrade the RNA in the soy protein. This would naturally flow from the prior art disclosure of the cited EP reference wherein the slurry is obtained and FINASE is applied (of which is an acid phosphatase enzyme) to the slurry to produce soy protein. Therefore, Applicants' argument that an acid phosphatase enzyme is not clearly disclosed is not deemed persuasive. Further, Applicants obtain their acid phosphatase enzyme from the same source as FINASE, and that being *Aspergillus* sp.

Applicants' direct their argument regarding the source of the enzyme to the showing of the declaration submitted under 37 CFR 1.132 wherein they show that Natuphos also obtained from *Aspergillus* is not an acid phosphatase but a phytase. However, FINASE and acid phosphatase are both disclosed by the EP reference.

Art Unit: 1651

Further, whether the reference must always contain acid phosphatase, in order to establish inherent anticipation based on alleged case law is noted, however, the claims are at least obvious from the teaching of FINASE even if Applicants ' are found persuasive. In addition, the degradation of phytates as disclosed would also guide one of skill in the art to degrade other components such as RNA, if so desired. The effect of degrading phytates would be the same effect for RNA using the same enzyme: acid phosphatase. Applicants have not shown that FINASE does not degrade acid phosphatase and the declaration is directed to a comparison of some other enzyme preparation which is not disclosed by the EP reference. Therefore, the declaration is not considered to be persuasive for the removal of EP reference as cited prior art. In further regard to the case law: Mehl/Biophile International Corp. it should be noted that the case was directed to hair material and not a soy protein material. Thus, enzymes behave differently with different substrates. For reasons of record and those discussed above the rejection is maintained.

All claims fail to be patentably distinguishable over the state of the art discussed above. Therefore, the claims are properly rejected.

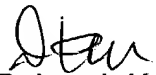
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

Art Unit: 1651

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Deborah K. Ware  
January 24, 2004

  
LEON B. LAWFORD, JR.  
PRIMARY EXAMINER